UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,961	10/30/2000	Darshatkumar Shah	MS150612.1	8291

27195	7590	10/31/2005	

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EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7,18-20,22,31,33-35 and 43-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7,18-20,22,31,33-35,43,44,46,47,49 and 50* is/are rejected.

7)☒ Claim(s) *45,48 and 51* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *9/30/2005*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment received on 8/15/2005 is acknowledged and entered.

Claims 1, 3, 7, 18, 20, 22, 31, and 33-34 have been amended, claims 6 and 37 have

been canceled, and new claims 43-51 have been added. Currently claims 1, 3-5, 7, 18-

20, 22, 31, 33-35 and 43-51 are pending for examination.

Response to Arguments

2.1.   The applicant's arguments (see Remarks, pages 8-11) filed on 8/15/2005

concerning rejection of claims 1, 3-7, 33-35 and 37 under 35 U.S.C. 101 have been fully

considered but are not persuasive for following reasons:

The claims 1, 3-7, 33-35 and 37 were directed to a system/machine comprising

that is a graphical image component, a shopping basket component, an interface, etc.

that is data per se without any supporting structure that is in combination with a

computer readable medium so as to be capable of producing a useful, concrete and

tangible result when used in a computer system is statutory i.e., a set of instructions in

combination with a computer system. C.f. *In re Wamerdam* - data structure stored in a

computer memory, and *In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994)* - data structure

in a computer readable medium and therefore do not fall into any of the statutory

categories, as defined by USC 101. As regards " State Street" decision, the system

claims included supporting structure in the form of a computer processing means, that is

a personal computer including a CPU, for processing data and a storage means for

storing data on a storage medium. In the instant application the claims 1, 3-7, 33-35 and

37 do not recite including any such machine. For the same reasons, currently amended

claims 1, 3-5, 7, 33-35 and new claims 43-45, 48-51 are rejected under 35 U.S.C. 101.

2.2.   Applicant's arguments with respect to rejection of claims 1, 3-7, 18-20, 22, 31,

33-35 and 37 under 35 USC 103 (a) have been considered but are moot in view of the

new ground(s) of rejection necessitated due to current amendments.

2.3.   In view of the current amendment of claim 22, earlier rejection of this claim as

being dependent of a canceled claim is withdrawn.

        This is a Final rejection.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

        Claims 1, 3-5, 7, 33-35 and 43-45, 48-51 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

        Claims 1, 3-5, 7, 33-35, 43-45, and 48-51 are directed to disembodied data

structure claim which are per se not statutory. C.f. In re Wamerdam. The claims 1, 3-

5,7, 33-35, 43-45 and 48-51 are directed to a system/machine comprising that is a

graphical image component, a shopping basket component, an interface, etc. that is

data per se without any supporting structure that is in combination with a computer

readable medium so as to be capable of producing a useful, concrete and tangible

result when used in a computer system is statutory i.e., a set of instructions in combination with a computer system. C.f. *In re Wamerdam* - data structure stored in a computer memory, and *In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994)* - data structure in a computer readable medium and therefore do not fall into any of the statutory categories, as defined by USC 101. As regards " State Street" decision, the system claims included supporting structure in the form of a computer processing means, that is a personal computer including a CPU, for processing data and a storage means for storing data on a storage medium. In the instant application the claims 1, 3-7, 33-35 and 37 do not recite including any such machine.

The examiner suggests to redraft the claims to include a machine, that is a computer readable medium so that the claimed software in combination with a computer readable medium will be capable of producing a useful, concrete and tangible result. A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete an tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101. See U.S. Patent 5,710,578 to Beauregard etc. These are merely stored to be read or outputted by a computer without any functional interrelationship, and thus do not impart functionality to the computer, i.e., they are not computer components. **Examples of Non-Functional Descriptive Material :Music, Literature, Art, Photographs, Data base per se are** directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention

set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of

invention in the alternative only. Id. at 1551.

Regarding claims 45, 48 and 51, their limitations are directed to claiming signals

per se having no tangible physical structure and are therefore not statutory subject

matter. The combination of signals with statutory physical structure may be statutory

subject matter if a useful, concrete and tangible result is produced. See, for example,

Koo Patent, U.S. Patent Number: 5,568,202. Signals *per se ha*ve no tangible physical

structure. A signal that is not tied to any physical structure for transmitting or receiving

the signal: do not perform any useful, concrete and tangible result and do not constitute

a tangible physical article or some form of matter. However, when a signal is coupled

with or combined with a statutory physical structure to produce a useful, concrete and

tangible result, the combination constitutes statutory subject matter.

Claim Objections

4.   Claims 45, 48 and 51 are objected to under **37 CFR 1.75(c)**, as being of

improper dependent form for failing to further limit the subject matter of a previous

claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the

claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 45, 48 and 51 recite electrical signal representations of components or

instructions of claims 43, 18 and 33 respectively. First, as analyzed above the signals,

per se, claimed without any supporting physical structure do not satisfy 35 USC 101.

Secondly, even if it is assumed that the claimed signals are combined with statutory

physical structure producing concrete, useful and tangible results they fail the

Infringement Test, see MPEP 608.01 (n). The test as to whether a claim is a proper

dependent claim is that it shall include every limitation of the claim from which it

depends (**35 U.S.C. 112**, fourth paragraph) or in other words that it shall not conceivably

be infringed by anything which would not also infringe the basic claim. Thus, for

example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting

the structure of claim 1 in which D was omitted or replaced by E would not be a proper

dependent claim, even though it placed further limitations on the remaining elements or

added still other elements. In the present case, the dependent claims 45 48 and 51 omit

the elements of their independent claims 43, 18 and 33 and are therefore not proper

dependent claims.   For example, claims 45 and 51 recite an electrical signal

representation of at least one component only and not of all the components of the base

claims 43 and 33 respectively, and claim 48 is directed to electrical signal

representations of the instructions but do not include the positive steps of identifying

items, linking the representation of each item, providing a shopping basket, providing an

ordering component of the base claim 18. A dependent claim is directed to a

combination including everything recited in the base claim and what is recited in the

dependent claim. It is this combination that must be compared with the prior art, exactly

as if it were presented as one independent claim.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.1.   Claims 1, 3-5, 7, 18-20, 22, 31, 33-35, 43-44, 46-47, and 49-50 are rejected

under 35 U.S.C. 103(a) as being unpatentable over McCollom et al. (US Patent

6,925,444 to be referred as McCollom) in view of Spiegel et al. (US Patent 6,629,079,

hereinafter referred to Spiegel)

Regarding claim 1, McCollom discloses a system which facilitates electronic

shopping comprising:

a graphical image component residing on a user interface (see Fig.19);

a search engine component associated with the graphical image component, the

search engine component identifying, items from a plurality of different merchants

based on user indicated criteria and aggregating and returning items having the user

indicated criteria to the graphical image component for display and selection by a user

(see at least the search icon on Fig.19 and col.5, lines 39-53,

"The consumer shopper system 70 provides a mechanism to the user to
register and list merchant advertisement and sales items by category and
keyword. The consumer shopper system 70 also provides the user the ability to
search merchant advertisements and purchase items by keyword, category and
store name. The consumer shopper system 70 provides the ability to identify
and display advertisements and items from featured merchants. The consumer
shopper system 70 provides the mechanism to allow the user to decide what
merchant advertisements to access and further allows the user to subscribe to
specific advertisements or advertisements with a particular category of

interest to be received.　The consumer shopper system 70 accomplishes a
subscription by filtering merchant advertisements and messages by category and
keyword. .... ".

Note this search engine resides on the client side in the consumer shopper

system 70);

a shopping basket component associated with the graphical image component,

the shopping basket component providing drag and drop capabilities wherein

wherein the user elects items by dragging and dropping items from a plurality of

different - merchants into the graphical image component, the representations of the

selected items having a description, the descriptions of the selected items being

provided by the plurality of different merchants and retained by the shopping basket

component (see at least the shopping basket icon in Fig.19, col.5, lines 55-65, Fig.17

and col.18, lines 9-64 which teaches that the shopping cart residing in the consumer

shopper system 70, that is on the user's computer and enables the user to hold items

selected from browsing and purchasing from a plurality of merchants. The items are

selected from a group of merchant products, advertisements, coupons, etc, see col.25,

lines 20-23 and the items are stored in the shopping basket with description such as

item description, SKU, price, etc. Provided by the merchants); and

an ordering component providing for concurrent ordering of at least two selected

items from different merchants (see at least Figs.18, 19 and col.18, line 65-col.19, line

42 which disclose ordering routines in the consumer shopper system of selected items

from different stores, such as Bares & Noble, 1 800 Flowers, etc.), the search engine

component, shopping basket component and ordering component residing on the user's

computer (already analyzed above that all these three components are residing in the

consumer shopper system 70 on the user's computer) .

In McCollom the shopping cart does not drag and drop items from different

merchants but instead teaches, see col.18, lines 18-27, an alternative way of selection

of items by clicking and then it extracts the item ID, item description, price, etc. from

the merchant and adds that information to it. The intended use of both the concepts,

that is dragging and dropping data in the shopping cart as claimed in the instant

application and clicking the selected item and the shopping cart extracting the required

data and adding that data to the shopping cart is same. Also, both the concepts are

well known in the prior art at the time of the applicant's invention. Regarding drag and

drop capability, see Spiegel, in the same field of endeavor, that is conducting electronic

commerce and using shopping cart to hold the selected items (see at least col.10, lines

31-65, ... *the shopping cart selection navigation bar can be used for dragging-and-dropping items*

into the various shopping carts. For example, a user may select an item by depressing a button on a

pointing device, then drag the selected item to the selection navigation bar, and drop the item into a

shopping cart by releasing the button. When an item is dragged-and-dropped into a shopping cart,

.... ". Note: The "MECC" limitation in Spiegel allows the user to identify items from a

plurality of sources. When the items are dragged and dropped into the shopping basket

they also retain their description in the shopping basket, see FIG.1 and col.5, lines 39-

51, " *FIG. 1 is a diagram of the display illustrating the use of a shopping cart for each electronic*

commerce context. **The display includes .... item detailed description 102,... .... The item**

detailed description contains information describing the item currently selected by the user.

This information may include pricing data, availability data, and a general description of the item.

. ". These purchase items can be selected from a plurality of Web pages, which represent a plurality of sources (see at least col.1, line 35-col.2, line 54-67, which suggests that the server computer systems provides and displays Web pages in HTML per user request and these web pages represent a plurality of sources as they could belong to different URLs. See also col.6, line 65-col.7, line 1, "*.... The server engine receives HTTP IS requests to access Web pages identified by URLs and provides the Web pages to the client systems*" and FIG.4.).

In view of Spiegel, it would have been obvious to one of an ordinary skill in the art to have modified McCollom at the time of the applicant's invention to incorporate an equivalent method of selecting and adding items by way of dropping and dragging items from merchants to the shopping carts as explicitly disclosed in Spiegel and analyzed above.

Regarding claim 3, McCollom discloses that the selected items from the plurality of different merchants having a common schema associated with the descriptions of the items (see at least col.4, lines 54-62. The common schema used in McCollom is HTML code).

Regarding claim 5, McCollom also discloses that in the system of claim 1, the user interface being an Internet browser (see at least Fig.3A, col.4, lines 54-62 and col.6, lines 12-27)).

Regarding claim 7, McCollom shows that the user interface being a desktop of the user's computer and the shopping basket component being a desktop application associated with the graphical image component (see at least Fig.19).

Regarding claim 43, McCollom teaches having a filtering component to limit the number of merchants (see at least col.5, lines 51-58 teaches using a filtering system to limit the number of merchants whose advertisement products and messages can be received by the consumer shopper system 70).

Regarding claim 44, McCollom teaches that the interaction of the plurality of different merchants with the system is facilitated by an application programming interface (see at least col.5, line 6-col.6, line 43 which shows that the consumer's access to various resources, such as merchants is implemented through an API).

Regarding method claims 18, 20, 22, and 46-47, their limitations are closely parallel to the limitations of claims 1, 3, 5, 7 and 43-44 and are therefore analyzed and rejected as being unpatentable over McCollom in view of Spiegel based on same rationale.

Regarding claim 31, computer readable medium having computer-executable components, its limitations are already covered in claim 1 and is therefore

analyzed and rejected as being unpatentable over McCollom in view of Spiegel based

on same rationale.

Regarding claims 33, and 49-50 its limitations are already covered in claims 1,

and 43-44 above and are therefore analyzed and rejected as being unpatentable over

McCollom in view of Spiegel based on same rationale.

Regarding claim 34, McCollom further teaches comprising a wish list

component that stores items that are automatically added to the electronic shopping

basket when user defined criteria are met (see at least col.12, line 64-col.14, line 9).

Regarding claim 35, McCollom further teaches that the electronic shopping

basket is invoked through one of an icon on a web browser and a selectable menu

option (see at least Figs 19 and 20 which shows that the shopping cart can be invoked

through one of an icon).

5.2.   Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McCollom in view of Spiegel and further in view of Call (US Patent 6,154,738).

Regarding claim 4, McCollom in view of Spiegel discloses that the identified

items from the plurality of different sources having a common schema associated with

the descriptions of the items, that is HTML code as analyzed above but does not

disclose that the common schema is XML schema. However, Call in the field of same endeavor, teaches that the identified items from the plurality of different sources having a common schema associated with the descriptions of the items and that common schema being an XML schema (see at least col.32, lines 20-41, "*The manufacturers preferably provide product information to their connected server in the form of well-formed eXtensible Markup Language (XML) documents which may be validated against a standard Document Type Definition (DTD) to which all such product information documents should conform. The schema to which such documents adhere may be advantageously expressed in the Resource Description Framework (RDF) and Syntax Specification, as noted earlier, to facilitate the evolution of standardized content definitions for product and company information. The shared product information server illustrated at 840, in its simplest form, does nothing more than make Internet accessible data storage space available where smaller manufacturers without their own servers can make product and company information available via the Internet.........*".). In view of Call, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified McCollom in view of Spiegel to incorporate the feature of having a common schema associated with the descriptions of the items, identified from a plurality of sources, and that common schema being an XML schema because it helps to present the data from different sources in a format being used by the local web page producer as explicitly shown in Call (see at least col.2, line 64-col.3, line 10).

Regarding claim 19, its limitations are already covered in claim 4 and is therefore analyzed and rejected on the same basis.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

        (i) US Patent 6,868,393 to Demsky et al. (see at least col.5, line 65-col.6, line 58) and US Patent 6,125,352 to Franklin et al (see at least Fig.4) disclose a system and method conducting electronic commerce based on client-server architecture with the shopping basket component residing on the user's computer and interacting with a plurality of merchants.

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
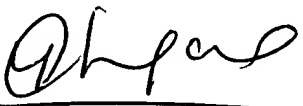
        A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
October 25, 2005